

**REMARKS****I. Claim Rejections – 35 U.S.C. 102****Requirements for *Prima Facie* Anticipation**

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the referenced cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show the reference cited by the examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of

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the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

### ***Suzuki***

In the office action dated October 18, 2005, the Examiner rejected claims 15-20 as being anticipated by Suzuki (U.S. Patent No. 6,129,274) under 35 U.S.C. § 102(b).

The Examiner argued that Suzuki discloses a point of sale (pos) terminal (citing reference numeral 12 of Suzuki) for processing economic credits (arguing incentive awards, coupons) and redeeming the economic credits at the pos via hand-held devices (arguing "smart card" and citing reference numeral 10 of Suzuki) having a memory (citing reference numerals 50, 52 of Suzuki) through a network (citing FIG. 1 of Suzuki).

The Applicant respectfully disagrees with this assessment.

Regarding claim 15, the Applicant submits that Suzuki fails to disclose any methods or processes. Suzuki does show various devices and systems, but does not disclose an actual process for transferring and redeeming negotiable economic credits based on a particular methodology, unlike the method/process of Applicant's claims.

Applicant's amended claim 15 provides for a method of processing negotiable economic credits through a hand held device, said method comprising the step of:

storing a user profile in a database within said hand held device;

transferring at least one negotiable economic credit to a retail enterprise through a network for use at a point of sale on behalf of a credit redemption request via a hand held device;

redeeming said at least one negotiable economic credit at said point of sale, in response to transferring said at least one negotiable economic credit to said point of sale from said hand held device;

transferring at least one updated negotiable economic credit from said point of sale from said retail enterprise to said hand held device in response to redeeming said at least one negotiable economic credit at said point of sale; and

thereafter storing said at least one updated negotiable economic credit in a memory of said hand held device for use in thereafter redeeming said at least one updated negotiable economic credit at a point of sale, in response to transferring said at least one negotiable economic credit to said point of sale from said hand held device; and

updating said user profile in response to redeeming said at least one negotiable economic credit at said point of sale.

The Applicant notes that Suzuki does not provide these particular method steps. For example, Suzuki does not provide for the step of redeeming said at least one negotiable economic credit at said point of sale, in response to transferring said at least one negotiable economic credit to said point of sale from said hand held device. Suzuki also does not provide for the step of transferring at least one updated negotiable economic credit from said point of sale from said retail enterprise to said hand held device in response to redeeming said at least one negotiable economic credit at said point of sale. Suzuki also does not provide for the step of thereafter storing said at least one updated negotiable economic credit in a memory of said hand held device for use in thereafter redeeming said at least one updated negotiable economic credit at a point of sale, in response to transferring said at least one negotiable economic credit to said point of sale from said hand held device. These are particular steps that must be followed in order to achieve a particular result as outlined in Applicant's specification. Such methods steps, including the particular sequence of such steps and the particular processing action (e.g., "in response to" another action) are not disclosed, suggested or taught by Suzuki.

Additionally, the Applicant notes that Suzuki does not teach, disclose or suggest the use of a user profile as taught by Applicant's invention. In light of the lack of the disclosure of all such claim limitations by Suzuki, the Applicant submits that the rejection to claim 16 based on Suzuki is traversed. The Applicant notes that the Examiner has failed to satisfy the *prima facie* anticipation test described above. That is, the Applicant has demonstrated that not all elements of a *prima facie* case of anticipation have been met by the Examiner's arguments. The Applicant has demonstrated that the Suzuki reference fails to disclose each every element in amended claim 15.

Regarding claim 16, the Examiner notes that claim 16 has been cancelled by amendment. In light of the cancellation of claim 16, the Applicant submits that the Examiner's arguments with respect to claim 16 are rendered moot.

Regarding claim 17, the Applicant notes that the arguments presented above against the rejection to claim 15 apply equally to the rejection to claim 17. Thus, because claim 17 is dependent upon and incorporates all of the claim limitations of claim 15, the rejection to claim 17 is also traversed.

Regarding claim 18, Suzuki fails to disclose all of the following claim limitations:

configuring said point of sale to communicate with a network server associated with said network; and

storing a security module within a memory location of said server for authenticating said at least one negotiable economic credit transferred from said hand held device to said point of sale.

The Applicant notes that Suzuki does not teach, suggest or disclose a security module nor a memory location of a server wherein the security module is stored. Suzuki also does not teach, suggest or disclose a security module for authenticating one or more economic credits in the manner taught by Applicant's invention. The Applicant invites the Examiner to review Applicant's specification

where a security module is described, (e.g., see security module 136 of FIGS. 19 and 20 of Applicant's specification), which can be configured with encryption/decryption and password protection feature.

The Examiner has not identified any portions of Suzuki, which disclose such a security module. For these reasons, the Applicant submits that the rejection to claim 18 fails to satisfy the test for prima facie anticipation as indicated above. Therefore, the Applicant submits that the rejection to claim 18 based on Suzuki has been traversed.

Regarding claim 19, Suzuki fails to disclose all of the following claim limitations: authenticating said at least one negotiable economic credit utilizing said security module, in response to transferring said at least one negotiable economic credit to said point of sale from said hand held device and prior to redeeming said at least one negotiable economic credit at said point of sale, in response to transferring. Again, the Applicant notes that Suzuki does not mention the use of a security module for authentication purposes and particularly, an authentication step that is performed in response to a particular action, i.e., the transfer of one or more economic credits to the point of sale from the hand held device prior to redeeming the credits. For these reasons, the Applicant submits that the rejection to claim 19 fails to satisfy the test for prima facie anticipation as indicated above. Therefore, the Applicant submits that the rejection to claim 19 based on Suzuki has been traversed.

Regarding claim 20, Suzuki fails to disclose all of the following claim limitations, including wherein the step of authenticating said at least one negotiable economic credit utilizing said security module, further comprises the steps of:

identifying a user profile associated with said hand held device, wherein said user profile is stored in a database within said server; and

verifying said user profile in order to authenticate said at least one negotiable economic credit utilizing said security module.

Again, Suzuki does not teach the use of a security module for verification and authentication purposes. Additionally, Suzuki does not teach the use of a user profile, nor a user profile associated with a hand held device, nor a user profile stored in a database within a server, nor a step of identifying the user profile, nor a step of verifying the user profile for authenticating the negotiable economic credit using the securing module. Thus, because all such claim limitations are not disclosed by Suzuki, the Applicant submits that the rejection to claim 20 under 35 U.S.C. 102 has been traversed.

The Applicant reminds the Examiner that in order to succeed in setting forth a rejection under 35 U.S.C. 102 based on a particular reference, the reference at issue must disclose each and every claim limitation of the rejected claim. If even one feature is lacking in the cited reference, the rejection fails and must be withdrawn. Based on the foregoing the Applicant submits that the rejection to claims 15-20 under 35 U.S.C. 102 has been traversed. The Applicant therefore respectfully requests withdrawal of the rejection to claims 15-20 under 35 U.S.C. 102.

## II. Conclusion

In view of the foregoing discussion, the Applicants have responded to each and every rejection of the Official Action. The Applicants have clarified the structural distinctions of the present invention by amendments herein. The foregoing discussion and amendments do not present new issues for consideration and no new search is necessitated. Such amendments are supported by the specification and do not constitute new matter.

Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the

undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: October 31, 2005



Kermit Lopez  
Attorney for Applicants  
Registration No. 41,953  
ORTIZ & LOPEZ, PLLC  
P.O. Box 4484  
Albuquerque, NM 87196-4484

Tel. (505) 314-1312  
Fax. (505) 314-1307